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09/280,601	03/29/1999	ZHOU YANG	OPT-20500	6081

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DELIO & PETERSON
121 WHITNEY AVENUE
NEW HAVEN, CT 06510

EXAMINER

SERGEANT, RABON A

ART UNIT	PAPER NUMBER
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1711

DATE MAILED: 07/31/2002

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 18

Application Number: 09/280,601

Filing Date: 03/29/99

Appellant(s): Yang et al.

John J. Tomaszewski

For Appellant

MAILED

JUL 30 2002

GROUP 1700

EXAMINER'S ANSWER

This is in response to the appeal brief filed April 1, 2002.

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(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

Appellant's brief includes a statement that claims 23-58 and 80-115 and claims 116-135 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

(8) *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

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(9) *Prior Art of Record*

No prior art is relied upon by the examiner in the rejection of the claims under appeal.

(10) *Grounds of Rejection*

The following ground(s) of rejection are applicable to the appealed claims:

Claims 121, 122 and 133 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The use of “and” and “or” within the Markush group language of claim 121, with respect to the definition of R³, renders the claims indefinite, because it is unclear if or what combinations are denoted by the language. The language does not parallel the language of previous claims.

Appellants have acquiesced to the rejection. See section IV of the appeal brief.

Claims 134 and 135 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The subject matter of amended claim 134 is confusing, because it specifies that the composition of claim 116 is in solution; however, the claim further states that this solution is bulk polymerized. Bulk polymerization excludes compositions in solution.

Appellants' have acquiesced to the rejection. See section IV of the appeal brief.

Claims 134 and 135 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey

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to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Appellants have failed to provide support for the concept of bulk polymerizing a solution. See previous rejection.

Appellants have acquiesced to the rejection. See section IV of the appeal brief.

Claims 134 and 135 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Appellants have claimed a curable monomer composition; however, appellants further refer to polymerization of the composition to form a terpolymer. However, it is unclear that claim 134 is directed to anything other than the monomer composition. It remains unclear how the polymerization language further modifies the composition.

Appellants' acknowledgment that claim 134, directed to a monomer composition which is in solution, is a "solvent" is not considered to clarify how the polymerization language further modifies or limits the composition.

Claims 116, 117, 124-132, 134, and 135 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

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Appellants have failed to indicate where support exists for stating that the polyene contains only vinyl functional groups. Within the parent application, this language was specified with a structural formula for the polyene, which contained only vinyl functional groups.

Despite appellants' response, the position is maintained that the statement that the polyene contains only vinyl functional groups, thereby excluding other functional groups, constitutes new matter when not presented with the structural formula which contains only vinyl functional groups. The specification fails to recite that only vinyl functional groups may be present within the polyene. Rather, the concept of using polyenes which only contain vinyl functional groups is only indirectly set forth by the formula at page 7, line 35 of the specification. To now expand the requirement that all of the polyenes, including those excluded by the formula, have only vinyl functional groups sets forth a concept not originally presented by appellants.

It is noted that the prior art rejection set forth within paragraphs 6-8 of the Office action of September 13, 2000 has been withdrawn in view of the claim limitation requiring the polyene to have only vinyl functional groups.

Claims 23-58 and 80-115 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The examiner has not found support for the range of polythiol compounds represented by formula (1) within claims 23, 27, and 55. Contrary to appellants' argument, the recitation of one

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species does not provide support for an entire genus of compounds. Also, clear support has not been found for the terminology, "neither a hydroxyl group nor a mercapto group", within claims 23, 27, 55, 80, 84, and 112. The position is taken that the disclosure of a number of specific compounds which lack a hydroxyl or mercapto group is not sufficient to provide support for an entire genus of compounds. Lastly, support has not been found for the claimed ratio range of 1.0 to 3.0 within claims 26, 30, 83, and 87. Support has only been found at page 11 for the ratio range of 1.05 to 2.0.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321© may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

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Claims 116-135 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-24 of U.S. Patent No. 6,008,296. Although the conflicting claims are not identical, they are not patentably distinct from each other because each set of claims is drawn to a composition comprising equivalent reactants.

Appellants have acquiesced to the rejection. See section V of the appeal brief.

(11) Response to Argument

Appellants arguments have been addressed within the Ground of Rejection.

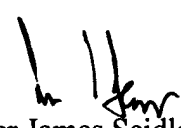
For the above reasons, it is believed that the rejections should be sustained.


Respectfully submitted,

Sergeant
July 27, 2002


RABON SERGENT
PRIMARY EXAMINER

Conferees:


Supervisory Patent Examiner James Seidleck


Supervisory Patent Examiner David Wu

Delio and Peterson
121 Whitney Avenue
New Haven, Connecticut 06510-1241